



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,899	07/11/2001	Steven C. Amendola	A34318; 065617.0139	9648

26345 7590 03/25/2005

GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE
1 RIVERFRONT PLAZA
NEWARK, NJ 07102-5497

EXAMINER

RIDLEY, BASIA ANNA

ART UNIT PAPER NUMBER

1764

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,899

Applicant(s)

AMENDOLA ET AL.

Examiner

Basia Ridley

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8,10,12,15-17 and 25-65 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,8,10,12,15-17,30,33-45,48 and 50-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,25-29,31,32,46,47 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 120301,100102,062603.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Invention I, Species a-1 and b-2, claims 1, 25-29, 31, 32, 46, 47 and 49 in the reply filed on 3 December 2004 is acknowledged. The traversal is on the ground(s) that because of the number of claims drawn to Inventions I and II, the search and examination of entire application can be made without a serious burden. This is not found persuasive establishing that the inventions are classified in different classes and/or subclasses establishes that a serious burden exists on the examiner if restriction is not required.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 12, 15-17, 42 and 58-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim.

3. Claims 3, 4, 8, 10, 30, 33-41, 43-45, 48 and 50-57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim.

Information Disclosure Statement

4. The information disclosure statement filed on 3 December 2001 fails to comply with the provisions of 37 CFR 1.98(b) for the reasons set forth below. It has been placed in the application file, but, unless the following reference has been cited by the examiner on form PTO-892, it has not been considered as to the merits:

- US Patent Application Publication 20010022960 is not an OTHER DOCUMENT but rather a US PATENT DOCUMENT and is not identified by a publication date.

Claim Objections

5. Claim 49 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim 46. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 25-29, 31-32, 46-47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Falter (USP 1,935,627).

Regarding claim 1, Falter discloses an arrangement comprising:

- a catalyst chamber (1) comprising a catalyst (P1/L88-94);
- a fuel chamber (2) comprising a reactant material capable of generating product when contacting said catalyst;
- a spent fuel chamber (27) connected to the catalyst chamber (1) for receiving said reactant material (P2/L46-82) after contacting said catalyst and for receiving the product generated by contacting the reactant material and the catalyst;
- a conduit (28) between the spent fuel chamber (27) and fuel chamber (2), the conduit (28)

Art Unit: 1764

including an outlet conduit (29).

While Falter does not explicitly disclose a check valve in the conduit (28) to which the outlet conduit (29) is connected, as the reference disclose that gas is vented through the conduit (29) periodically, as necessary (P2/L82-88), the presence of a check valve is inherent in the arrangement of Falter.

Regarding limitations recited in claim 1 which are directed to a manner of operating disclosed arrangement, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

Regarding claims 25-29 and 31-32, Falter discloses an apparatus comprising:

- a fuel container (2) having an internal pressure;
- a reactant material capable of generating product disposed within said container (2);
- said container having an outlet port which can be opened and closed (P1/L77-81).

Regarding limitations recited in claims 25-29 and 31-32 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended

Art Unit: 1764

operation are of no significance in determining patentability of the apparatus claim.”

Regarding claims 46-47 and 49, Falter discloses an arrangement comprising:

- a catalyst chamber (1) comprising a catalyst (P1/L88-94);
- a fuel chamber (2) configured to retain a reactant material under a predetermined pressure, said reactant material capable of generating product when contacting said catalyst;
- a spent fuel chamber (27) connected to the catalyst chamber (1) for receiving said reactant material after its contact with said catalyst and for receiving product generated by the contact of the reactant material with the catalyst;
- wherein said fuel chamber includes an exit valve (P1/L77-81).

Regarding limitations recited in claims 46-47 and 49 which are directed to a manner of operating disclosed arrangement, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

8. Claims 1, 25-29, 31-32, 46-47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuderer (USP 4,553,981).

Regarding claim 1, Fuderer discloses an arrangement for generating hydrogen gas comprising:

- a catalyst chamber (5) comprising a catalyst;
- a fuel chamber (2) comprising a reactant material capable of generating hydrogen gas when

Art Unit: 1764

contacting said catalyst;

- a spent fuel chamber (9) connected to the catalyst chamber (5) for receiving said reactant material after contacting said catalyst and for receiving the hydrogen gas generated by contacting the reactant material and the catalyst;
- a conduit (20, 21, 23) between the spent fuel chamber (9) and fuel chamber (2), the conduit (20, 21, 23) including an outlet conduit (25).

While Fuderer does not explicitly disclose a check valve in the conduit (20, 21, 23) to which the outlet conduit (25) is connected, the presence of a check valve is inherent in the arrangement of Fuderer to prevent uncontrolled release of gas from the conduit (20, 21, 23).

Regarding limitations recited in claim 1 which are directed to a manner of operating disclosed arrangement, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim."

Regarding claims 25-29 and 31-32, Fuderer discloses an apparatus for use in a system for generating hydrogen, said apparatus comprising:

- a fuel container (2) having an internal pressure;
- a reactant material capable of generating hydrogen disposed within said container (2).

While Fuderer does not explicitly disclose said container (2) having an outlet port which can be opened and closed, the presence of a port which can be opened or closed is inherent in the

Art Unit: 1764

apparatus of Fuderer to prevent uncontrolled release of material from the container (2).

Regarding limitations recited in claims 25-29 and 31-32 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim."

Regarding claims 46 and 49, Fuderer discloses an arrangement for generating hydrogen comprising:

- a catalyst chamber (51) comprising a catalyst;
- a fuel chamber (2) configured to retain a reactant material under a predetermined pressure, said reactant material capable of generating hydrogen gas when contacting said catalyst;
- a spent fuel chamber (9) connected to the catalyst chamber (5) for receiving said reactant material after its contact with said catalyst and for receiving hydrogen gas generated by the contact of the reactant material with the catalyst.

Regarding claim 47, while Fuderer does not explicitly disclose said container (2) having an exit valve, the presence of an exit valve is inherent in the apparatus of Fuderer to prevent uncontrolled release of material from the container (2).

Regarding limitations recited in claims 46-47 and 49 which are directed to a manner of operating disclosed arrangement, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate

Art Unit: 1764

apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

9. Claims 25-29, 31-32, 46-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Kojima et al. (US 2001/00229600).

Regarding claims 25-29 and 31-32, Kojima et al. discloses an apparatus for use in a system for generating hydrogen, the apparatus comprising:

- a fuel container (1) having an internal pressure;
- a reactant material capable of generating hydrogen disposed within said container (2);
- said container having an outlet port (3) which can be opened and closed (6).

Regarding limitations recited in claims 25-29 and 31-32 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

Regarding claims 46-47 and 49, Kojima et al. discloses an arrangement for generating hydrogen comprising:

- a catalyst chamber (2) comprising a catalyst (5);
- a fuel chamber (1) configured to retain a reactant material (4) under a predetermined

Art Unit: 1764

pressure, said reactant material (4) capable of generating hydrogen gas when contacting said catalyst (5);

- a spent fuel chamber (8) connected to the catalyst chamber (2) for receiving said reactant material after its contact with said catalyst (5) and for receiving hydrogen gas generated by the contact of the reactant material (4) with the catalyst (2);
- wherein said fuel chamber includes an exit valve (6).

Regarding limitations recited in claims 46-47 and 49 which are directed to a manner of operating disclosed arrangement, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

10. Claims 25-29, 31-32, 46-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Amendola et al. (US 2003/0037487).

Regarding claims 25-29 and 31-32, Amendola et al.’ 487 discloses an apparatus for use in a system for generating hydrogen, the apparatus comprising:

- a fuel container (101) having an internal pressure;
- a reactant material capable of generating hydrogen disposed within said container (101);
- said container having an outlet port which can be opened and closed (see [0044]-[0045]).

Regarding limitations recited in claims 25-29 and 31-32 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material

Art Unit: 1764

or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

Regarding claims 46-47 and 49, Amendola et al’487. discloses an arrangement for generating hydrogen comprising:

- a catalyst chamber (107) comprising a catalyst;
- a fuel chamber (101) configured to retain a reactant material under a predetermined pressure, said reactant material capable of generating hydrogen gas when contacting said catalyst;
- a spent fuel chamber (102) connected to the catalyst chamber (107) for receiving said reactant material after its contact with said catalyst and for receiving hydrogen gas generated by the contact of the reactant material with the catalyst (see [0045]);
- wherein said fuel chamber includes an exit valve (see [0044]-[0045]).

Regarding limitations recited in claims 46-47 and 49 which are directed to a manner of operating disclosed arrangement, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

Art Unit: 1764

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

11. Claims 25-29, 31-32, 46-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Amendola et al. (US 2004/0033194).

Regarding claims 25-29 and 31-32, Amendola et al.' 194 discloses an apparatus for use in a system for generating hydrogen, the apparatus comprising:

- a fuel container (130) having an internal pressure;
- a reactant material capable of generating hydrogen disposed within said container (140);
- said container having an outlet port (160) which can be opened and closed.

Regarding limitations recited in claims 25-29 and 31-32 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim."

Regarding claims 46-47 and 49, Amendola et al. 194 discloses an arrangement for generating hydrogen comprising:

Art Unit: 1764

- a catalyst chamber (170) comprising a catalyst;
- a fuel chamber (130) configured to retain a reactant material (140) under a predetermined pressure, said reactant material capable of generating hydrogen gas when contacting said catalyst;
- a spent fuel chamber (200) connected to the catalyst chamber (170) for receiving said reactant material after its contact with said catalyst and for receiving hydrogen gas generated by the contact of the reactant material with the catalyst;
- wherein said fuel chamber includes an exit valve (210).

Regarding limitations recited in claims 46-47 and 49 which are directed to a manner of operating disclosed arrangement, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 25-29, 31-32, 46-47 and 49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 09/900,625. Although the conflicting claims are not identical, they are not patentably distinct from each other because said claims 25-29, 31-32, 46-47 and 49 of the instant application recite only the limitations which are recited in claims 1-34 of copending Application No. 09/900,625.

Regarding limitations recited in claims 25-29, 31-32, 46-47 and 49 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim."

Art Unit: 1764

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 25-29, 31-32, 46-47 and 49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/638,651. Although the conflicting claims are not identical, they are not patentably distinct from each other because said claims 25-29, 31-32, 46-47 and 49 of the instant application recite only the limitations which are recited in claims 1-13 of copending Application No. 10/638,651.

Regarding limitations recited in claims 25-29, 31-32, 46-47 and 49 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1, 25-29, 31-32, 46-47 and 49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/223,871. Although the conflicting claims are not identical, they are not patentably distinct from each other because said claims 1, 25-29, 31-32, 46-47 and 49 of

Art Unit: 1764

the instant application recite only the limitations which are recited in claims 1-18 of copending Application No. 10/223,871.

Regarding limitations recited in claims 1, 25-29, 31-32, 46-47 and 49 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states "Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 25-29, 31-32, 46-47 and 49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/359,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because said claims 25-29, 31-32, 46-47 and 49 of the instant application recite only the limitations which are recited in claims 1-28 of copending Application No. 10/359,104.

Regarding limitations recited in claims 25-29, 31-32, 46-47 and 49 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process

Art Unit: 1764

limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 25-29, 31-32, 46-47 and 49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of copending Application No. 10/115,269. Although the conflicting claims are not identical, they are not patentably distinct from each other because said claims 25-29, 31-32, 46-47 and 49 of the instant application recite only the limitations which are recited in claims 1-45 of copending Application No. 10/115,269. While claims 1-45 of copending Application No. 10/115,269 do not explicitly recite a chamber including an exit valve, presence of said valve would be inherent in the apparatus recited in said claims 1-45 of copending Application No. 10/115,269.

Regarding limitations recited in claims 25-29, 31-32, 46-47 and 49 which are directed to a manner of operating disclosed apparatus, neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115. Further, process limitations do not have patentable weight in an apparatus claim. See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) that states “Expressions relating the apparatus to contents thereof and to an intended operation are of no significance in determining patentability of the apparatus claim.”

Art Unit: 1764

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

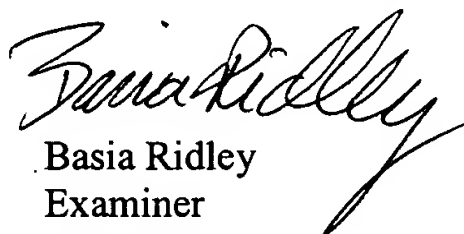
18. In view of the foregoing, none of the claims are allowed.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Basia Ridley, whose telephone number is (571) 272-1453.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola, can be reached on (571) 272-1444.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Technical Center 1700 General Information Telephone No. is (571) 272-1700. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Questions on access to the Private PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Basia Ridley
Examiner
Art Unit 1764

BR
March 18, 2005